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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/874,150 | 06/05/2001 | Gordon D. Boulger | G03.010 | 5909 |

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EXAMINER

SHEIKH, ASFAND M

ART UNIT PAPER NUMBER

3627

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/874,150 | Applicant(s) BOULGER, GORDON D. | |
| | Examiner Asfand M. Sheikh | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-22 and 29 are rejected under 35 U.S.C. 101 because they fail to produce a tangible result.

As per claim 1-14, In order for claimed subject matter to be considered patent eligible under 35 U.S.C. 101 it must contain a tangible result. The focus of this determination is on the result of the claim as a whole, not the individual steps or structure used to produce the result. Further to be tangible the process claim must set forth a practical application thereby producing a real-world result. It is the position of the Examiner that the result of the Applicant's claimed invention is the step of determining if the payable amount is less than or equal to an approved amount. Further, this determination does not produce a tangible (real-world) result. Therefore the claims are found to be directed towards subject matter, which is not patent eligible under 35 U.S.C. 101.

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As per claims 15-22 and 29, the 35 U.S.C. 101 rejection is substantially similar to that of claims 1-14, and further a useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable exception or it is merely likely that it would occur, it does not "flow inherently therefrom" and the claim would need to specifically recite the result. The Examiner notes that the presence of the "if" raises a question since it appears that when the "if" is not satisfied then there would be no tangible result. It is the position of the Examiner that the result of the Applicant's claimed invention is the step of determining if the payable amount is less than or equal to an approved amount. Further, this determination does not produce a tangible (real-world) result. Therefore the claims are found to be directed towards subject matter, which is not patent eligible under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 30-58, 59 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 30, 44, 47, 52, 58, 59 and 60, The Examiner notes that claims are directed to a medium storing processor-executable process, which renders the claims indefinite. The Examiner is unclear whether the claim is directed to a product or a process. The Examiner will interpret the claims as a product. The Examiner further notes as a product, a medium/storage device should not include steps; it should include code or instructions.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaggi United States Patent 6,973,441.

As per claim 1, Jaggi discloses receiving a code and a payable amount associated with an expense (col. 20, lines 25-32; Examiner interprets "billing code" to be a code and "legal fee" to be the payable amount associated with "the service" which is an expense); identifying a user associated with the code (col. 20, lines 37-40; Examiner interprets "communicates the discrepancy to the in-hour patent attorney" to be associating the code to a user); presenting the expense to the user (col. 20, lines 37-40; The Examiner interprets "communicates the discrepancy to the in-hour patent attorney" to be presenting the expense (e.g. discrepancy) to the user); receiving an

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instruction to pay the payable amount (col. 19, lines 54-63 and col. 20, lines 33-37; Examiner interpreters "amounts billed were previously approved for payment" to be an instruction to pay the payable amount); and determining if the payable amount is less than or equal to an approved amount associated with the code (col. 20, lines 63-66).

As per claim 2, Jaggi discloses issuing a command to pay the payable amount if it is determined that the payable amount is less than or equal to the approved amount (col. 20, lines 63-66).

As per claim 3, Jaggi discloses decrementing the approved amount associated with the code based on the payable amount (col. 20, lines 63-67 and col. 21, lines 1-3; Examiner interprets "schedules the amount for payment and notes such in the budget database" to be decrementing the amount associated with the code based on the payable amount).

As per claim 4, Jaggi discloses wherein the instruction is received from the user (col. 19, lines 54-63; Examiner interprets "in-house patent attorney... information on the form

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includes the legal fee budget..." to be an instruction associated to pay the payable amount).

As per claim 5, Jaggi discloses associating an associated approved amount with each of a plurality of codes (col. 18, lines 47-51).

As per claim 6, Jaggi discloses wherein the code represents a vendor (col. 19, lines 29-44; Examiner interprets "checks the task budget database for the particular law firm" would be codes representing a vendor).

As per claim 7, Jaggi discloses wherein the code represents a project (col. 18, lines 47-51).

As per claim 8, Jaggi discloses wherein the code represents a purchase order (col. 17, lines 54-67 and col. 18, lines 1-21 and lines 33-46; Examiner interprets "law firm and company may agree, on a base amount" and "billing codes (e.g., 'pre-pare and file patent application' for task - '7,5000.00')" to be a code that represents a purchase order).

As per claim 9, Jaggi discloses analyzing a data structure comprising one or more users associated with each of a plurality of codes (col. 21 lines 4-19; Examiner interprets "the computer system generates communication to the in-house patent attorney and/or in-house paralegal advisor" to be analyzing a data structure comprising one or more users associated with each of a plurality of codes).

As per claim 10, Jaggi discloses associating one or more users with each of a plurality of expense codes (col.18, lines 47-51, col. 19, lines 29-44 and col. 21 lines 4-19).

As per claim 11, Jaggi discloses wherein the instruction is received from the user (col. 19, lines 54-63), wherein the identifying step comprises identifying a second user associated with the code (col. 21, lines 4-19; Examiner interprets "in-house paralegal to be a second user), and further comprising: receiving a second instruction to pay the payable amount from the second user (col. 21, lines 4-19).

As per claim 12, Jaggi discloses issuing a command to pay the payable amount if the first instruction (col. 19, lines 55-53 and col. 20, lines 33-37) and the second instruction (col.

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21, lines 4-19) have been received and if it is determined that the payable amount is less than or equal to the approved amount (col. 20, lines 63-66).

As per claim 13, Jaggi discloses presenting the expense to the second user (col. 21, lines 4-19).

As per claim 14, Jaggi discloses sending an electronic mail message to the user (col. 21, lines 4-19), the electronic mail message (col. 2, lines 56-62 and col. 21, lines 4-19; Examiner interprets "communication" to be an electronic mail message) including a selectable link (col. 3, lines 27-35); receiving an indication that the link has been selected (col. 3, lines 27-35); and presenting information representing the expense to the user (col. 20, lines 37-40).

As per claim groups 15-17; 18-22; 23-28; 29; 30-43; 44-46; 47-51; 52-57; 58; 59; 60; and 61-64, are substantially similar to claims 1-14, thus Examiner establishes similar grounds of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

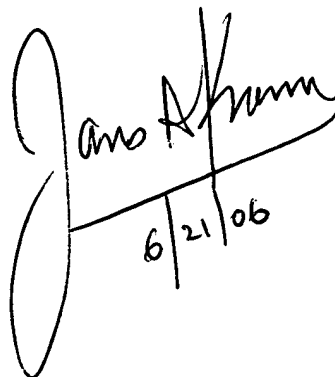
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

Asfand M Sheikh
Examiner
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6/21/06